

REMARKS

Please reconsider this application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of the claims

Claims 1-8 were pending in this application. New claims 9-11 are added by way of this reply. Claims 1, 5, and 8 are independent. Claims 2-4 and 9-11 depend, directly or indirectly, from claim 1. Claims 6 and 7 depend directly from claim 5. No new matter is added by way of these new claims as support may be found, for example, in paragraphs [0029] and [0036] and Figure 2 of the published specification.

Rejections under 35 U.S.C. §103

Claims 1-8 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 5,481,610 (“Doiron”) in view of U.S. Patent Application Publication No. 2003/0182565 (“Nakano”) and U.S. Patent No. 7,058,805 (“Sibert”). Applicant respectfully traverses the rejection as follows.

MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Further, when combining prior art elements, the Examiner “must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art

being the lack of actual combination of the elements in a single prior art reference..." *See MPEP § 2143(A).*

Embodiments of the claimed invention relate to a digital video disc (DVD) device. Particularly, an encryption system is claimed including a detachable and rewritable flash memory containing program information and an area of prescribed size that contains key data. The key data allows for accessing information of a DVD. The key data is recorded in a prescribed address, and is surrounded by random data, making illicit decryption more difficult. Further, the key data, within the random data, is surrounded by program data, making the key data indistinguishable from the random data and the program data. Key data writing equipment is also configured to modify the key data.

The key data may be mounted to DVD equipment during manufacture and allow the equipment to read encrypted DVDs that are placed in the equipment. (Published Specification, ¶ [0030]). According to limitations of the claimed invention, the rewritable flash memory is detachably attached to the DVD equipment and, therefore, the flash memory may be removed from the equipment and the key data may be mounted to additional equipment. (Published Specification, ¶¶ [0032]-[0033]). Additionally, as the key data, random information, and program information are all contained on one flash memory the program information and key information may be written at one time. Further, the detachable and rewritable flash memory may be attached to a computer or other key data writing equipment to be modified. (Published Specification, ¶¶ [0035]-[0036]).

The Examiner has admitted that the prior art fails to show the detachable nature of the flash memory, as claimed. (Office Action, April 1, 2010, page 3). We note that the Examiner failed to address the Applicant's arguments regarding the critical nature of the removability limitation and that *In re Dulberg* is inapplicable to the application.

The Examiner argued that making separable is an obvious change over the prior art, and, therefore, the claimed limitations are unpatentable, citing *In re Dulberg*. (Office Action, page 3, April 1, 2010). However, the separable cap of *Dulberg* is not analogous to the claimed detachable flash memory. Specifically, the cap in *Dulberg* was attached to a lipstick holder and was “press fitted.” The accused product in that case had the cap manually removable. The court held, in *Dulberg*, that “if it were considered desirable for any reason to obtain access to the end of [the prior art’s] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.” However, as the Examiner noted in the Office Action of April 1, 2010, making separable makes no difference if the two configurations “produce the same kind of output (result).”

In a distinguishing case, *For Your Ease Only, Inc. v. Natural Science Industries, Ltd.*, 233 F.Supp.2d 988 (N.D. Ill. 2002), the court stated that “*Dulberg* does not ‘espouse a general principle that removability cannot make an invention....’” The court in *For Your Ease* held that it would not be appropriate to rely solely on *Dulberg* as a basis for obviousness when the limitations in question are critical limitations. A “‘critical limitation’ is customarily understood as ‘one essential either to the operativeness of the invention or to the patentability of the claims.’” (citing *Storchheim v. Daugherty*, 410 F.2d 1393, 1396 (Cust. & Pat.App.. 1969) (emphasis added)).

The claim limitations directed to the removably detachable flash memory are critical to the claims, and, further, are essential to the patentability of the claims. In particular, a key for decoding and operating a DVD is traditionally physically part of the DVD player, as shown in the cited prior art and well known in the art. (*See*, Nakano, element 103a, and Sibert, Figures 4a and 4b). In contrast, the claimed invention removes the keys from the hardware of the DVD player and makes the key detachably removable. Applicant asserts that it would not have been obvious to modify an element traditionally embedded in hardware for security reasons into a removable element. Advantageously, the removable aspect of the claimed invention allows for easy mounting of the keys and, further, allows for mounting of the keys on additional equipment, other than a single DVD player. (*See*, Published Specificaiton, ¶¶ [0030]-[0033]).

Moreover, the detachable memory of the claimed invention allows for different results than the mounted memory of the prior art, thereby further distinguishing the claimed invention over the prior art. In particular, the detachable flash memory, as claimed, allows for transferability and mobility of the key data such that the data may mounted repeatedly to multiple and/or different apparatuses, as discussed above. Such a result is not possible under the teaching of Nakano, Doiron, and Sibert, or any combination thereof. Accordingly, the output (result) of the claimed invention is different from the prior art, and, therefore, *In re Dulberg* is inapplicable to this application.

As such, the detachably removable rewritable flash memory is a critical element of the claimed invention and produces results distinct from that of the prior art, and is, therefore, not obvious in view of the prior art. Accordingly, the independent claims 1, 5, and 8 are patentable over

Doiron, Nakano, and Sibert, whether considered separately or in combination. Claims 2-4, 6, and 7 are patentable over the references for at least the same reason. Withdrawal of this rejection is respectfully requested.

New Claims

Claims 9-11 are added by way of this reply. Claims 9-11 are directed to clarifying the key data that is stored on the removable flash memory. In particular, claim 9 further limits the key data to include key data for CPRM and key data for CPPM. Further, claim 10 limits the location of the key data for CPRM to a first address within the prescribed area and the location of the key data for CPPM to a second address within the prescribed area. Finally, claim 11 recites that the first and second addresses (the key data for CPRM and the key data for CPPM) are separated by random data. No new matter is added by way of these new claims as support may be found, for example, in paragraphs [0029] and [0036] and Figure 2 of the published specification. Entry and favorable consideration of these new claims is respectfully requested.

New claims 9-11 are patentable over the cited references as none of the references disclose that the key data includes key data for CPRM and/or key data for CPPM. Further, Nakano, Doiron, and Sibert, whether considered separately or in combination, fail to suggest locating the key data at two independent addresses within the prescribed area, and that the two addresses are separated by additional random data, as required by claims 10 and 11, respectively. Accordingly, new claims 9-11 are patentable over Nakano, Doiron, and Sibert, whether considered separately or in combination.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 04536/034001).

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